

REMARKS

Applicants are in receipt of a further Office Action from the United States Patent and Trademark Office with regard to the matter captioned above. That action was dated January 7, 2005, and the action taken therein was made final.

Claims 23-26 and 28 were pending in the application. All of those claims are presently subject to rejection. Claim 28 (the only independent claim) and Claims 23-26, each dependent, directly or indirectly, upon Claim 28, are rejected under 35 U.S.C. § 102(b). The examiner took the position that those five claims are fully anticipated by the teachings of United States Patent No. 1,819,295 (Holt). The specific bases for rejection are documented in paragraphs 2 and 4 on pages 2-3 of the Office Action papers.

In response to the Office Action, the undersigned requested a telephonic interview with Examiner Lopez, and Examiner Lopez indicated that her primary or supervisory examiner would have to be present for such an interview. A telephonic interview was held on February 3, 2005. Examiner Michelle Lopez and her primary examiner, Examiner John Sipos, were present in a conference room at the United States Patent and Trademark Office, and the undersigned and David Dornbush, an officer of a potential corporate manufacturer of a product in accordance with the invention, were present in the conference room at the offices of Nawrocki, Rooney & Sivertson, P.A., the law firm to which power of attorney is granted in the case. Mary Ponthan, one of the inventors, was present in the conference room at the PTO with Examiners Lopez and Sipos.

The attention and cooperation of Examiners Lopez and Sipos during the interview are sincerely appreciated. It is felt that their attention to the arguments made during the interview and the demonstration which compared a structure in accordance with the present invention to a mock-up of the Holt structure will move this case along to issuance.

The Interview Summary form signed by Examiner Sipos stated: "Applicant's representative stated that Holt does not show two dissociated features that are part of a head of a figure and that 'neck' 21 of Holt is not part of the head. Alternative language will be considered for 'character effigy', 'head' and 'practical'. Examiner will call Applicant's representative with further consideration." It was understood that the examiner was to call Applicant's representative after Examiner Lopez and Examiner Sipos had a chance to consider and propose language which would overcome any basis for rejection under § 112 and place the application into condition for allowance. There was certain language which the examiners felt was objectionable under § 112. Specifically, the examiners cited "character effigy", "head" and "practical".

No proposed language has been forthcoming, and Applicants, therefore, by this document, propose language which, it is submitted, obviates any basis for rejection under § 112. Specifically, the claims now make reference to creation of an "effigy". This is language originally used in the claims but deleted by a previous amendment because of a prior examiner's taking of issue with the term. It is sincerely believed, however, that the term "effigy" is the most appropriate terminology to provide an acceptable breadth and to accurately characterize the invention. It would be pointed out that Webster's New Twentieth Century Dictionary, Unabridged, Second Edition (1971), while including a number of other definitions of the term "effigy", has one which merely defines the word as a "representation". It is felt that this definition appropriately characterizes the structure which is created in accordance with method Claim 28.

Further, Claim 28 has been amended such that reference is made to a "feature of an effigy head" rather than to a head characteristic or feature. It should be clear that, while any number of features can be involved, the example that has typically been discussed has made reference to eyes, as one feature, and a

blanket fringe which, when the manipulating step is performed, suggests hair of the effigy in view of its positioning relative to the eyes, as a second feature. Further, it will also be understood, however, that features of an effigy head are "unrelated" when the item is in its first configuration (that is, when the item is laid out to define a surface which is generally flat).

With regard to the objection to prior use of the term "practical", it will be noted that that term has been changed to "blanket". That is, in the first configuration (the one where a surface which is generally flat is defined), a blanket function is served by the item.

Although not discussed in detail, it appeared during the interview that there was some objection to use of the term "dissociated". It was understood that this term, in the examiner's opinion, not only gave rise to possible problems under § 112, but also that it apparently created an issue with regard to prior art. In any case, the first and second features are now defined as being "unrelated" when the item is in the first configuration and give no suggestion to a complete effigy head in that configuration.

With regard to the relevancy of the Holt patent, Applicants submit that, while it teaches some of the limitations of Claim 28, that reference neither fully discloses nor suggests the method of Claim 28. Exhibit A hereto is a chart which itemizes all of the elements of Claim 28. In the second column, it comments upon the relevance and teachings of the Holt reference relative to all limitations.

Exhibit A acknowledged that the Holt patent does teach certain elements of Claim 28 of the present application. Specifically, Holt deals with a method of creating an effigy by providing an item which is flexible and is configurable between first and second configurations. It also teaches the definition of a surface which is generally flat when the item is in the first configuration and

the portraying at a location on the generally flat surface, proximate a first edge, a first feature of an effigy head. And, since a head is fully depicted in Holt thereby associating all features of a head even in the first configuration, that reference does, arguably, teach the portrayal of a second feature of an effigy head on the generally flat surface. It is reiterated, however, that the multiple features are already fully related to one another to depict a head in the first configuration.

Finally, the Holt handkerchief doll would appear to be a complete effigy when in the second configuration, a body of the effigy being simulated in that configuration.

The elements that are failed to be satisfied by Holt, however, are extremely significant. In addition to the fact that, while a second head feature is provided as discussed above, since no second feature of an effigy head is shown as unrelated to a first feature in the first configuration, Holt is deficient in other respects. Claim 28 requires that, when the item is in its first configuration, first and second effigy head features are unrelated so as to give no suggestion of a complete effigy head. Holt gives absolutely no teaching with respect to this limitation. In both its first and second configurations, the structure of Holt fully depicts the effigy head. Nothing is left to the imagination in either configuration.

In the presently outstanding Office Action, the examiner took the position that reference numeral 21 in Holt identifies a second effigy head feature, a neck. It is submitted, however, that Holt never identifies a "neck". Further, even if a neck were identified, a neck cannot qualify as a feature of an effigy head. The gist of the dictionary definition of neck is that it is a connector between the head and the torso. It does not, therefore, qualify as part of the head.

While the present invention, as defined by Claim 28, does simulate an effigy body, the focus of the claim, in view of the

defined steps, is bringing together effigy head features to suggest the effigy's head.

Claim 28 also defines a unique manner of manipulating the item from the first configuration to the second configuration. The specifics of this manipulation facilitate the achievement of the goal of suggesting the effigy's head. While Holt teaches a manipulation step, that step is performed differently than is required by Claim 28.

As previously pointed out, Claim 28 has been amended to define the item as serving a blanket function when it is in the first configuration. Holt has no such teaching.

The final limitation of Claim 28 is that, in the second configuration, the first and second features of an effigy head are positioned appropriately with respect to the simulated body formed by the manipulation of the item to suggest the effigy's head. Again, Holt definitely does not satisfy this limitation. It is not possible to say that the features merely "suggest" the head. Rather, the Holt reference, when the structure is in the second configuration, teaches an explicit depiction of an effigy head. In fact, such a depiction occurs in all configurations, and such a depiction is the antithesis of the invention of Claim 28.

The essence of Claim 28 is a method of manipulating the item between a first configuration, wherein an effigy head is neither depicted nor suggested, and a second configuration, wherein an effigy head is merely suggested. The invention thereby calls into play the need for a child to exercise imagination in mentally creating the effigy because of the manner of manipulation. The Holt reference, plain and simply, does not call for the exercise of imagination that the present invention does.

It is submitted that this AMENDMENT AND REQUEST FOR RECONSIDERATION introduces no new issues with regard to novelty and non-obviousness. While language is amended, the amendments are directed to § 112 issues. Arguments offered with regard to

distinguishing over the Holt reference are made to make clear the bases for distinguishing over Holt and to address the examiner's rejection under § 102. Consequently, this document does not necessitate any further searching, and it is appropriate, it is submitted, to allow the application at this time.

In view of the action taken herein and arguments offered in support of patentability, it is, therefore, respectfully asserted that the case is in condition for allowance. Allowance and the taking of action pursuant thereto are, therefore, earnestly solicited. If any action other than full allowance is intended in response to the filing of this paper, a call by the examiner to the undersigned would be sincerely appreciated.

Reconsideration is hereby respectfully requested.

Please charge any deficiencies or credit any over payment to Deposit Account 14-0620.

Respectfully submitted,

Mary M. Ponthan et al.

By their attorney

Date March 1, 2005

Lawrence M. Nawrocki

Lawrence M. Nawrocki
Reg. No. 29,333
NAWROCKI, ROONEY & SIVERTSON, P.A.
Suite 401, Broadway Place East
3433 Broadway St. N.E.
Minneapolis, MN 55413
(612) 331-1464